

REMARKS**The 35 U.S.C. §102 Rejections**

Claims 39, 40, 42-45, 55, and 60-63 have been rejected under 35 U.S.C. § 102(e), as being anticipated by U.S. Pat. No. 5, 952, 998 to Clancy et al. (Clancy). As the Examiner has addressed arguments only to claims 39, 55, and 60, Applicant will follow suite. If the Examiner intends to maintain the 102(e) rejection against claims 40, 42-45, 61 and 62, Applicant respectfully requests that arguments be presented to that effect.

The test for anticipation is symmetrical to the test for infringement and has been stated as: "That which would literally infringe [a claim] if later in time anticipates if earlier than the date of invention." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); *Connell v. Sears Roebuck & Co.*, 722 F.2d 1542, 1548, 220 U.S.P.Q. 1931, 1938 (Fed. Cir. 1983). Moreover, the single source must disclose all of the claimed elements "arranged as in the claim." *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984). Also, each and every element as set forth in the claim must be found, either expressly or inherently described, in a single prior art reference. MPEP 2131.

Claim 39 has been amended to include the limitations of claim 44. Claim 39 recites, in part:

a substrate;

a sensory array disposed on the substrate and comprising a plurality of substantially transparent conductive traces disposed along a first axis, the sensory

array covering a portion of the substrate, wherein the sensory array is configured to sense capacitively the input object along a second axis;

a substantially transparent ground plane coupled to the bottom of the substrate and configured to shield electrically the sensory array; and

a sensing device for detecting capacitance changes on said sensory array.

Clancy fails to disclose the added limitation to claim 39. Rather, Clancy discloses a transparent plastic film secured above a membrane, which is secured above a screen. Col. 4 line 62 - col. 5 line 4. Clancy fails to anticipate claim 39.

Claim 55 recited, in part, wherein a bottom of said sensory array is electrically shielded using a substantially transparent ground plane. The Examiner has failed to meet the burden required in maintaining a 102 rejection, as no mention of a substantially transparent ground plane is made regarding claim 55. Moreover, Clancy fails to disclose a substantially transparent ground plane. Clancy fails to anticipate claim 55.

Claim 60 has been amended to recite, in part, a transparent capacitive touch sensing system comprising conductive traces in the X axis and the Y axis that form a substantially space-filling pattern. Clancy fails to disclose conductive traces that form a substantially space-filling pattern, rather, Clancy goes to some length to describe how non-space filling patterns may be achieved and shows a pattern with significant amounts of space (see Fig. 5, Clancy). Clancy fails to anticipate claim 60.

Claims 64-68 have been rejected under 35 U.S.C. § 102(e), as being anticipated by U.S. Pat. No. 6,411,344 to Fujii et al. (Fujii). Claim 64 recites, in part, *a plurality* of first

conductors *disposed along an X axis directly on* said top polarizer layer; and a *plurality* of second conductors *disposed along a Y axis* and insulated from said plurality of first conductors disposed along said X axis. Fujii fails to disclose the cited portion of claim 64. Rather, Fujii recites a polarizing plate connected to a first conductive substrate (Figs. 1 and 2, col. 6 lines 25-50), or a polarizing plate connected to a first retardation film (Fig. 3, col. 8, lines 35-38). Nowhere does Fujii disclose all the elements of claim 64. If the Examiner maintains the rejection, Applicant respectfully requests that the Examiner specifically identify each element of claim 64. Fujii fails to anticipate claim 64. Claim 64 is in condition for allowance.

Claims 65-67 depend from claim 64 and are also not anticipated by Fujii. Claims 65-67 are in condition for allowance.

Claim 68 recites, in part, a transparent touchpad disposed on said top polarizer layer, including *a plurality of conductors* disposed along at least one axis *directly on* said top polarizer layer. Although claim 68 differs from claim 64, the same argument applied to claim 64 applies to claim 68. Fujii fails to disclose a plurality of conductors directly on said top polarizer layer. If the Examiner maintains the rejection, Applicant respectfully requests that the Examiner specifically identify the plurality of conductors directly on said top polarizer layer. Fujii fails to anticipate claim 68.

Claims 69-72 have been rejected under 35 U.S.C. § 102(b), as being anticipated by U.S. Pat No. 4, 931,782 to Jackson (Jackson). Claim 69 recites, in part, a plurality of first conductors disposed along an X axis *directly on* said glass envelope. Jackson fails to anticipate claim 69 because Jackson recites that the array of transparent conductors 34 is

separated from the glass display surface 13 of the CRT by a lower substrate 32 and a layer of transparent adhesive 33. See Figs. 2 and 3, col. 10 lines 6-19. Therefore, Jackson fails to anticipate claim 69. Claim 69 is in condition for allowance.

Claims 70-72 depend from claim 69 and are also not anticipated by Jackson. Claims 70-72 are in condition for allowance.

Claim 77 has been rejected under 35 U.S.C. § 102(b), as being anticipated by U.S. Pat. No. 4,290,052 to Eichelberger et al. (Eichelberger). Although Eichelberger mentions a fingerprint (col. 1, lines 48-51), nowhere does Eichelberger recite a fingerprint sensor. Eichelberger cannot anticipate claim 77. If the Examiner maintains the rejection, Applicant respectfully requests that the fingerprint sensor in Eichelberger be identified. Applicant suggests that a fingerprint sensor is distinct from a finger sensor, capacitive or otherwise. Claim 77 is in condition for allowance.

Claim 78 has been rejected under 35 U.S.C. § 102(e), as being anticipated by U.S. Pat. No. 5,909,211 to Combs et al. (Combs). Claim 78 recites, in combination: a graphic underlay; and a transparent touchpad disposed on said graphic underlay, including a plurality of conductors disposed along at least one axis directly on said graphic underlay. Combs fails to anticipate claim 78 because Combs recites that the invention provides a device that can detect an *overlay* on a digitizer pad. Furthermore, with an overlay there is no need for a transparent touchpad, which Combs also fails to disclose. Therefore, Combs does not anticipate claim 78. Claim 78 is in condition for allowance.

Claims 79-81 have been rejected under 35 U.S.C. § 102(e), as being anticipated by Clancy. Claim 79 recites, in part, wherein the capacitive sensor has a substantially

uniform transmissivity within said active area. Clancy fails to recite the above portion of claim 79. In fact, Clancy specifically addresses a case where transmissivity is a problem. "In the case where the traces 72 and 76 are not completely transparent, the capacitive elements and traces may interfere to some degree with the image." Col. 8 lines 27-29. Therefore, Clancy does not anticipate claim 79. Claim 79 is in condition for allowance.

Claims 80 and 81 depend from claim 79 and are also not anticipated by Clancy. Claims 80 and 81 are in condition for allowance.

The 35 U.S.C. §103 Rejections

Claims 39-45, 55, and 60-63 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 5,861,875 to Gerpheide (Gerpheide) in view of U.S. Pat. No. 6,414,671 to Gillespie et al. (Gillespie). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996). See also MPEP § 2142.

Claim 39 has been amended to include a substantially transparent ground plane coupled to the bottom of the substrate and configured to electrically shield the sensory array. The recited portion of claim 39 is from cancelled claim 44, which the Examiner admits is not contained within the cited art. Merely reciting that an electrical shield plate

is known in the art is not sufficient to uphold the Examiners burden with respect to a 103 rejection. Absent official notice, it is never appropriate to rely solely on “common knowledge” in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697. See also MPEP 2144.03. Additionally, the Examiner indicated, at the latter portion of section 9 of the office action, that claim 44 was objected to and would be allowable if rewritten in independent form with all intervening dependencies. Applicant respectfully requests this inconsistency be corrected. Neither Gerpheide nor Gillespie, either alone or in combination, teach or suggest claim 39. Claim 39 is in condition for allowance.

Claims 40-43 and 45 depend from claim 39 and are not anticipated by Gerpheide or Gillespie, either alone or in combination. Claims 40-43 and 45 are in condition for allowance.

Claim 55 recites, in part, wherein a bottom of said sensory array is electrically shielded using a substantially transparent ground plane. Although claims 55 and 39 differ, the same argument applied to claim 39 applies here. Claim 55 is not obvious over Gillespie in view of Gerpheide. Claim 55 is in condition for allowance.

Claim 60 recites, in part, a substantially transparent two-dimensional sensory array consisting of a plurality of substantially transparent conductive traces in an X axis and a plurality of substantially transparent conductive traces in a Y axis for sensing capacitive coupling between an input object and said sensory array along two axes, wherein said conductive traces in the X axis and the Y axis form a substantially space-filling pattern. Gerpheide discloses that beneath the electrode array 94 is the sense electrode 96. The

active sensing area is defined as the area where the electrode array 94 and the sense electrode 96 overlap. Mutual capacitance is always determined with respect to the sense electrode 96. Col. 8 lines 37-65. Gerpheide fails to teach or suggest the recited portion of claim 60 because all sensing in Gerpheide is in relation to the sense electrode, rather than within the sensory array of claim 60. Neither Gerpheide nor Gillespie, either alone or in combination, teach or suggest claim 60. Claim 60 is in condition for allowance.

Claims 73-76 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Clancy in view of Fujii. Applicant maintains that the Examiner has improperly combined references by not stating what the motivation to combine would have been, nor that such a combination would have been successful. Each of Fujii and Clancy provide touchpads in conjunction with LCDs, so combining them would provide nothing new or beneficial. Applicant respectfully suggests that the Examiner has failed to meet the burden of proof required under § 103. Claims 73-76 are in condition for allowance.

Applicant respectfully requests that the Examiner allow all the claims and direct the application to issue.

In view of the foregoing, consideration and an early allowance of this application are earnestly solicited.

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